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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,466	11/14/2005	Gerhard Albrecht	MBZ-0465	4840
23575 7590 08/30/2007 CURATOLO SIDOTI CO., LPA 24500 CENTER RIDGE ROAD, SUITE 280 CLEVELAND, OH 44145			EXAMINER MARCANTONI, PAUL D	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 08/30/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/524,466	Applicant(s) ALBRECHT ET AL.	
	Examiner Paul Marcantoni	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 19-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's arguments filed 7/30/07 have been fully considered but they are not persuasive. Applicants' amendment canceling claims 1-18 and adding new claims 19-32 necessitated the rejection over the new claims as stated below:

35 USC 103

Claims 19-32 are rejected under 35 USC 103(a) as being unpatentable over Schapira et al. '236 or alone or in view of Albrecht et al. (US Patent No. 5,369,198), Caspar et al. '784, Burge et al. '154 or '144, or Shimizu et al. '164 B2.

*Note 1: For a more specific recitation of this rejection, please refer to the examiner's previous office actions. (with respect to Schapira alone or in view of Albrecht '198).*

*Note 2: The italicized secondary references were added to this rejection to teach that mortar and concrete can be sprayed (see claims). It would have been an obvious design choice to make the mortar or concrete of Schapira sprayable as mortar and concrete can be made sprayable as shown by these references.*

Previous Response:

Schapira:

First, as stated in the previous final rejection of 10/30/06, Schapira does provide motivation to combine references. Schapira teach the addition of citric acid as stabilizing agent (col.3, lines 24-30) and also 2-phosphobutane 1,2,4 tricarboxylic acid (col.5, lines 45-52). Schapira further teach that the composition of his invention can be used simultaneously with the superplasticizers of the prior art (col.7, lines 17-18). Albrecht et al. do teach a plasticizer (or superplasticizer) that is a prior art and a known and conventional superplasticizer already in use in the prior art. It would have been an obvious design choice for one of ordinary skill in the art to substitute one known superplasticizer for another known superplasticizer (Albrecht '198) because they are both functionally equivalent (This is the motivation for examiner's combination).

The applicants argue Schapira individually and do not address the combination in stating that they do not teach the copolymer plasticizer (component (3)). There is no disagreement but it is improper for applicants to argue or attack references individually and not address the combination of references in the rejection. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicants also argue that the prior art does not teach a sprayable cement but merely grouts, slags, concretes, and mortars. In response, the examiner has added Caspar et al. '784, Burge et al. '154 or '144, or Shimizu et al. '164 B2 to the combination reference to teach that mortar and concrete can be sprayable and control of the properties to do so thus would have been an obvious design choice for one of ordinary skill in the art. Thus, applicants' arguments that Schapira could not be sprayable are not persuasive because concrete and mortar can be made sprayable.

It is also noted that for all product claims (including claim 1 to a fluidizing admixture) that the sprayability of this cement mixture is an intended use. The new use of a known composition is not a patentable distinction.

The applicants argue that their superplasticizer (which is the same as a plasticizer, water reducing agent, superplasticizer, liquefier, or dispersing agent-see col.1, lines 22-23 of Albrecht '198) cannot be substituted for Schapira's superplasticizer. The examiner disagrees. Both have the same function in a cement and both would have been expected thus to be functionally equivalent. (This is the motivation to combine references). Further, as mentioned previously, the Schapira cement composition can be made sprayable as the added secondary references above teach that both concrete and mortar can be made sprayable. One of ordinary skill in the art could control the properties of the Schapira cement to make it sprayable.

Response to 7/30/07 Arguments:

Schapira Alone:

The applicants argue that the 35 USC 103 rejection over Schapira could not stand alone. The examiner disagrees. While Schapira does not specifically teach the applicants' claimed plasticizer, Schapira teaches that their composition may be used with the superplasticizers of the prior art (col.7, lines17-18). While Schapira does not teach the applicant's specific superplasticizer, the applicants' superplasticizer component (3) is merely another known and conventional plasticizer available to applicants at the time of their invention functionally equivalent to other known and available superplasticizers. Applicants did not provide any unexpected results showing their own composition would result in an unexpected property not within the teaching of

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the prior art via experimental evidence under 37 CFR 1.132. The examiner maintains that without this data there is no showing that one known superplastizer leads to a result unexpected over other known superplasticizers.

Schapira et al. '236 or alone or in view of Albrecht et al.198 and references teaching spraying of cement mixtures:

The applicants allege that the prior art composition can not be sprayed. The examiner disagrees and notes one of ordinary skill in the art has the capability of adjusting the ability of a cement slurry properties (ie viscosities, etc.) to be sprayed. Schapira even teaches the same composition and only differs in that he does not teach a specific superplasticizer. The fact that the examiner's position is that the use of one known superplasticizer for another because they function the same would give credence to the position that this composition could be sprayed. The examiner has made a case of prima facie obviousness and the burden is upon applicants to show that this composition could not be sprayed even if using a different and functionally equivalent superplasticizer to that used in their instant invention.

The applicants also put out the fact that the KSR decision reinforces what was always carried out in Graham v Deere as well as secondary considerations (e.g. commercial success, long felt need, failure of others etc.). In rebuttal, the examiner has made a proper 103 rejection in accordance with Graham v Deere and showed that the motivation to combine is the use of another known superplasticizer would have been an obvious design choice because they are functionally equivalent. The applicants have

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provided no 132 declaratory evidence with respect to commercial success, failure of others, long felt need, etc. so these secondary considerations have not been given any weight because applicants have not provided this information.

The applicants also mention the Adams decision (1996) yet they themselves have failed to provide any showing of unexpected results via 132 declaration or other means. Absent a showing of unexpected results, the prima facie case of obviousness is not overcome.

The applicants allege in the second to last paragraph on page 16 of their response that Schapira's composition can not be sprayed. Again, where is the experimental evidence? Applicants provide no 132 evidence attesting and showing that this prior art composition could not be sprayed. The applicants mention the use of not excessively retarding the mixture. Despite that, how does that mean Schapira's composition cannot be sprayed? The examiner maintains that the applicants are well aware that Schapira can be sprayed as shown by the secondary references of *Caspar et al.* '784, *Burge et al.* '154 or '144, or *Shimizu et al.* '164 B2. One of ordinary skill in the art has the capability of adjusting cement slurry properties for compositions such as concretes, mortars, etc. to make them sprayable.

The applicants also mention shelf life regarding an unexpected property yet the prior art also teaches their claimed composition as shown by the 103 rejection and it too would have been expected to have exceptional shelf life properties.

The examiner has fully responded to applicants' arguments and the finality of this office action is now proper. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1755